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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,409	03/28/2002	Hideki Aikoh	10873.882USWO	4963
23552	7590	03/17/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DINH, TAN X	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/089,409

Applicant(s)

AIKOH ET AL.

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004 and 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/04/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

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1) The amendment filed 7/14/2004 and 10/22/2004 are acknowledged. Claims 7 and 14-17 have been canceled.

2) The I.D.S filed 6/04/2002 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) Claims 12-14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not reference to two sets of claims to different features ( claim 12-14 recite an optical disk device for recording and reproducing which different feature of optical disk of read-only or partial ROM of claims 1-4 ). See MPEP § 608.01(n). Accordingly, the claims 12-14 are not been further treated on the merits.

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the

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examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6) Claims *1,3 and 5* are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGATAKI et al ( 5,527,479 ).

NAGATAKI et al discloses an optical recording medium as claimed in claims 1,3 and 5, comprising a substrate ( Fig.1, substrate 1 ), a pit information surface ( Fig.1, 3 ), a protective layer formed of an ultraviolet curable resin coated with silicone oil ( Fig.1, protective layer 6 coats with silicone oil layer 7. See also column 5, lines 45-53 ), which suites for floating type magnetic field modulation of sliding type magnetic field modulation ( column 1, lines 9-18 and column 2, lines 1-6 ), except to specifically show that the optical recording medium is read-only or partial recorded disk. It would have been obvious to someone within the level of skill in the art at the time of the invention was made to replace the optical recording medium of NAGATAKI et al by a read-only or partial recorded optical disk as claimed, the rationale is as follows: (a) the read-only optical

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disk and partial recorded optical disk are old and widely used in the art, evidence on KAMEZAKI et al ( 5,904,969 ), figure 6, 11a, and in NISHIUCHI et al ( 5,764,619 ) column 26, lines 8-14, and (b) in column 1, lines 9-18 NAGATAKI et al teaches that his invention is used to lubricate in general for use in magnetic recording, optical recording, magneto-optical recording and like recording media in the form of disk, tape, etc., which includes any types of optical recording medium ( read-only optical disk, partial recorded optical disk, etc., ), therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to use the lubricated as taught by NAGATAKI et al on read-only optical disk or partial recorded optical disk as claimed.

7) Claims 2,4,6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGATAKI et al (5,527,479) further in view of KAMEZAKI et al ( 5,904,969 ).

NAGATAKI et al discloses an optical disk as claimed in claims 2,4 and 11, comprising a substrate ( Fig.1, substrate 1 ), a pit information surface ( Fig.1, 3 ), a protective layer formed of an ultraviolet curable resin coated with silicone oil ( Fig.1, protective layer 6 coats with silicone oil layer 7. See also column 5, lines 45-53 ), which suites for floating type magnetic field modulation of sliding type magnetic field modulation ( column 1, lines 9-18 and column 2, lines 1-6. In this case,

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protective layer 6 coats with silicone oil is capable for any types of magneto-optical recording disks ), except to specifically show a printing layer. KAMEZAKI et al from the same field teach an optical recording medium having a printing layer ( Figure 5, printing layer 8 ). It would have been obvious to someone within the level of skill in the art at the time of the invention was made to use a printing layer in NAGATAKI et al's optical disk, the rationale is as follows: the technique of using printing layer for labeling the optical disk are widely used in the art as seen in KAMEZAKI et al's figure 5, printing layer 8, every optical disk, such as, CD, DVD or MD, are included a printing layer for displaying the graphic, label or other information related to the optical disk, the printing layer can be placed at any locations on the disk, under or over the protective layer since the protective layer is transparent. Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to use a printing layer under transparent protective layer as claimed.

As to claim 6, the disk cartridge for housing optical disk is old and well known in every mini-disk (MD) as seen in the prior art figures 3A and 3B.

As to claim 8, it would have been obvious to coat a lower viscosity on read-only optical disk than magnetic field modulation type magneto-optical disk since on read-only optical disk the magnetic head does not perform recording and erasing, just

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reproducing only, during sliding or floating, the magnetic head and the protective layer will be damaged, by coating a lower viscosity on read-only optical disk the damage of magnetic head and protective layer is reduced to minimal.

As to claims 9 and 10, it would have been obvious to record an identification data on the optical disk or optical disk cartridge since the method for identification of any characteristic on the optical by labeling have been widely used in the optical recording art.

8) Applicant's arguments with respect to claims 1-6,8-14 have been considered but are moot in view of the new ground(s) of rejection.

9) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure ( See form PTO-892 attached herein ).

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (571)272-7586. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

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The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH  
PRIMARY EXAMINER

March 15, 2005